

Appl. No. 09/581,345
Amdt. dated May 28, 2004
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

REMARKS/ARGUMENTS

I. Status of the Claims

Claims 113-121 and 123-165 are pending. Claims 113-119, 121, and 123-165 have been indicated to be allowed in the Advisory Action dated January 8, 2004. Claim 120 stands rejected.

II. The Amendments Herein

No new matter is added by the amendments herein. Claim 120 has been amended to recite that the heavy and light chains of the dsFvs are connected by a disulfide bond between cysteines which are located at designated positions in the chains as those positions are determined under the numbering of Kabat and Wu. The pairs of cysteines recited are supported by, e.g., U.S. Patent No. 5,747,654 (formerly U.S. Application No. 08/077,252. The '252 application is incorporated by reference in the present application.)

Entry of the amendment is appropriate at this time as it places the claims in condition for allowance or, in the alternative, places the application in better condition for appeal.

III. The Office Action

The Action indicates that claims 113-119, 121, and 123-165 are allowed. The sole remaining rejection is a rejection of claim 120. The Advisory Action indicates that the '252 application (now the '654 patent) "only supports disulfide bonds between specified residues in the light and heavy chains such as those in column 5". According to the Action, "[t]he claims [presumably meaning claim 120] are broader and can encompass any pairs."

Applicants observe that the language of claim 120 as presented basically tracked that of claims 2 and 11 of the '654 patent, and therefore is presumptively enabled. Applicants also observe that, even if dsFvs could not be made from combining some of the particular

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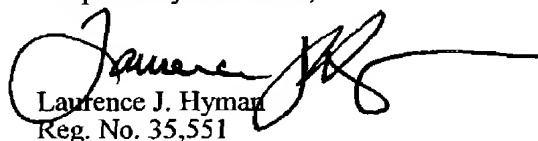
residues recited in the claim, it would be immaterial. The Examiner is respectfully reminded that claims are allowed to read on non-working embodiments so long as it is possible, as here, for the practitioner readily to test whether any particular embodiment is operative. To expedite prosecution however, claim 120 has been amended to recite the particular pairs of cysteines recited at column 5 of the '654 patent.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,


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